

REMARKS

Claims 8-10 and 12-14 were pending at the time of the Office action. Claims 8-10 and 12-14 stand rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness.

Claims 8-10 and 13 stand rejected under 35 U.S.C. § 103(a) for obviousness over Jaynes et al. (Plant Science 89:43-53, 1993) in view of Daniell et al. (U.S. Patent No. 5,693,507).

Claims 8-10 and 13 stand further rejected under 35 U.S.C. § 103(a) for obviousness over Keen et al. (Biotechnology in Plant Disease Control (Chet, ed.), pp. 65-88, 1993).

Applicants address each of these rejections below.

Claim amendments

Claim 8 has been amended to include all of the features of dependent claim 12. In addition, claim 8 has been amended to clarify that the transformation of step (b) results in expression of the candidate gene and the reporter gene, as well as to recite “detecting the presence or absence of a disease-resistance response in said plant tissue sample...” Claim 14 has been amended to correct the claim dependency and to clarify that the histochemical detection occurs in step (c), i.e., the detection step. Support for these amendments is found, e.g., on page 47, lines 23-29; page 48, lines 1-7; and page 49, lines 3-9, of the specification as filed. No new matter has been added by the present amendments.

Claims 9-10 and 12-13 have been cancelled. Applicants note that the present

amendments were made solely to expedite prosecution, and applicants reserve the right to pursue the cancelled subject matter in this or in a continuing application.

Rejection under 35 U.S.C. § 112, second paragraph

Claims 8-10 and 12-14 stand rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. Claims 9-10 and 12-13 have been cancelled, and therefore this basis of rejection is moot with respect to these claims. Regarding claims 8 and 14, the Office states (page 2):

It is unclear in claim 8, step (c), what the practitioner of the method does to express the candidate gene and the reporter gene in the plant tissue sample.

Applicants have amended claim 8 to clarify that expression of the candidate gene and the reporter gene occurs as a consequence of the transformation step, without necessarily requiring action by the practitioner. Support for this amendment is found, e.g., on page 48, lines 1-7, of the specification as filed.

In addition, the Office states (page 3):

Claim 8 is indefinite in its recitation of “determining” in part (d), as this is a mental process and not an active, positive step.

Claim 8, as amended, no longer recites “determining,” instead reciting in step (c) (previously step (d)), “detecting the presence or absence of a disease-resistance response in said plant tissue sample...” This language clarifies that the practitioner performs an

active, positive step when carrying out step (c). Support for this amendment is found, e.g., on page 47, lines 23-29, of the specification as filed.

The Office further states (page 3):

Claim 8 is indefinite in its recitation of “plant disease resistance gene” and “reporter gene.” A gene consists of a coding region as well as all the 5’ and 3’ regulatory regions associated with it. However, dependent claims 10 and 13 suggest that Applicant intends other regulatory regions to be associated with plant disease resistance and reporter coding regions.

In response, applicants draw the Office’s attention to the definition of “disease resistance gene” in the specification, which is defined as “a gene encoding a polypeptide capable of triggering the plant defense response in a plant cell or plant tissue” (page 10, lines 12-19, of the specification as filed). Likewise, a “reporter gene” is defined as “a gene whose expression may be assayed” (page 12, lines 28-31, of the specification as filed). Any 5’ or 3’ regulatory regions that are consistent with the above definitions may be used, including those recited in claims 10 and 13 (now cancelled). Therefore, applicants submit that claim 8 is not indefinite in its recitation of these genes.

Finally, the Office states (page 3):

It is unclear in claim 14 if “differences in GUS activity are detected histochemically” somehow further limit “GUS” or if this is an additional method step. If the latter, it is unclear where this step occurs in the method.

Claim 14 has been amended to clarify that the histochemical detection occurs in step (c), i.e., the detection step, of claim 8. Support for this amendment is found, e.g., on page 49, lines 3-9, of the specification as filed.

In view of the above amendments and arguments, applicants respectfully request that the rejection under 35 U.S.C. § 112, second paragraph, be withdrawn.

Rejections under 35 U.S.C. § 103(a)

Claims 8-10 and 13 stand rejected under 35 U.S.C. § 103(a) for obviousness over Jaynes et al. (Plant Science 89:43-53, 1993) in view of Daniell et al. (U.S. Patent No. 5,693,507). Claims 8-10 and 13 stand further rejected under 35 U.S.C. § 103(a) for obviousness over Keen et al. (Biotechnology in Plant Disease Control (Chet, ed.), pp. 65-88, 1993). Claims 9-10 and 13 have been cancelled, and claim 8 has been amended to include all of the features of dependent claim 12, which the Office acknowledges is free of the prior art (page 6). Therefore, the rejections under 35 U.S.C. § 103(a) are moot.

Allowable subject matter

The Office states (page 6):

Claims 12 and 14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

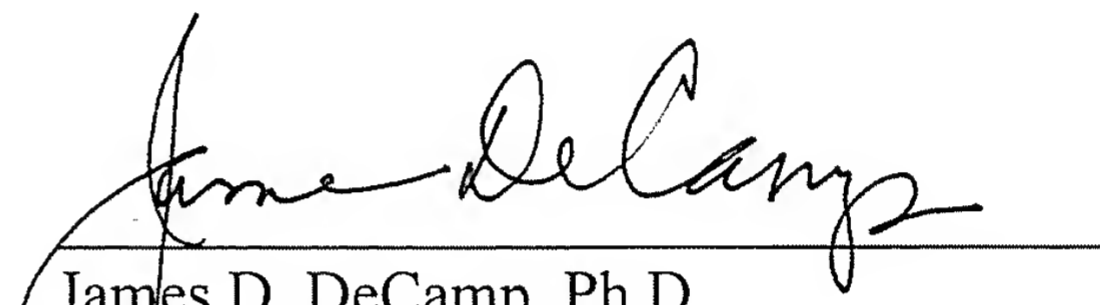
As noted above, claim 8, as amended, includes all of the features of dependent claim 12, and the dependency of claim 14 has been amended to depend from claim 8. In addition, claims 8 and 14 have been amended to overcome the rejection under 35 U.S.C. § 112, second paragraph. All other claims have been cancelled.

CONCLUSION

Applicants submit that the claims are now in condition for allowance, and such action is respectfully requested. If there are any charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

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